

Application No.: 10/774,264
Amendment dated July 6, 2006
Reply to Office Action of March 7, 2006

REMARKS

Applicants respectfully request entry of the above amendments, and consideration of the application as amended.

By the above amendment Applicants have amended claims 1, 10, 23, 29, 37, 54, 61, 63, and 66-69. Applicants also cancelled claims 7 and 60. No new matter was introduced.

Claims 1, 3, 4, 9, 10, 12-14, 23-25, 29-39, 50, 51, 54-59, and 61-69 are now pending in this application.

The Applicant acknowledges with appreciation the helpful assistance provided by Examiner David Reese in a phone conversation with the Applicant's undersigned Agent on June 13, 2006.

1. Response to Objections to the Specification

In paragraph 2 on page 2 of the Action, the Patent Office objected to the Specification for not supporting the subject matter in then-pending claims 68 and 69. The Applicant believes that the above Amendment addresses these objections and requests that these objections be withdrawn. The amendments to claims 68 and 69 were discussed during the above-reference phone conversation and were generally agreed upon by Examiner Reese. Should the Applicant's understanding of the phone conversation differ from Examiner Reese's, the Applicant's undersigned Agent requests that Examiner Reese call him at the number provided to discuss claims 68 and 69.

2. Response to Rejections under 35 USC §112

In paragraph 3 on page 2 of the Action, the Patent Office rejected claims 68 and 69 under 35 USC §112 for failing to comply with the written description. The Applicant believes that the above Amendment addresses these rejections and requests that these rejections be withdrawn.

Application No.: 10/774,264
Amendment dated July 6, 2006
Reply to Office Action of March 7, 2006

In paragraph 4 on page 3 of the Action, the Patent Office rejected claim 7, 66, and 67 under 35 USC §112 for being indefinite. The Applicant believes that the above Amendment addresses these rejections and requests that these rejections be withdrawn.

3. Response to Anticipation Rejection based upon EP 0200924 of Bortoluzzi

In paragraphs 5 and 6 on pages 3 and 4 of the Office Action, the Patent Office rejected claims 1, 3, 4, 9, 10, 12-14, 23-25, 50, 54-58, 63, and 64 under 35 USC §102(b) as anticipated by European Patent Application EP 0200294 [herein "the EP Application"]. However, Applicants submit that the above amendment of claim 1 overcomes these rejections.

The conditions for which an anticipation rejection is appropriate as defined in MPEP § 2131 were outlined in Applicants' earlier response dated July 29, 2005 (the disclosure of which is incorporated by reference herein in its entirety) and, though applicable to this rejection, are not repeated here for the sake of brevity.

With respect to claims 1, 23, and 54, the Applicant submits that the EP Application does not include "each and every element" of the invention recited in amended claim 1, nor does the EP Patent show the invention "in as complete detail" as in claim 1.

First, with respect to claims 1, 23, and 54, contrary to the comments made by the Patent Office, the Applicant submits that cited Figure 11 of the EP Application does not disclose a wire connector having a first end engaging an aperture in a first ornament and a second end engaging an aperture in a second ornament. As illustrated in Figure 11 and described in the first full paragraph on page 11 of the EP Application, the wire 14 of the EP Application engages one and only one rivet 10, as shown in Figure 12. As described briefly on page 11, "the crystal element 65 is fastened by means of its two opposite rivets 10 on a loop 114 formed by the wire 14 wound around the respective rod 5." That is, contrary to the comments made by the Patent Office, wire 15 - as clearly

Application No.: 10/774,264
Amendment dated July 6, 2006
Reply to Office Action of March 7, 2006

shown in Figure 11 -- does not extend to "the ornament above or below." Wire 14 ends just above ornament 10 and extends no further. Thus, the Applicant submits that the EP Application does not anticipate claims 1, 23, and 54, and respectfully requests that these rejections be reconsidered and withdrawn.

Also, claims 1, 23, and 54 have been amended to recite that the wire connectors be "inserted into and bent to engage" the ornament apertures. As clearly shown in Figures 11 and 12 cited by the Patent Office in the above-referenced Office Action, the wires 14 of the EP Application are wrapped around rivets 10 mounted in apertures in ornament 6. This aspect of the present invention is illustrated throughout the instant specification and drawings, for example, as shown in Figures 11 and 12. Contrary to the inventions recited in claims 1, 23, and 54, the wires 14 of the EP Application are not inserted in the apertures of ornament 6. The Applicant submits that amended claims 1, 23, and 54 are not anticipated by the EP Application.

Moreover, the Applicant submits that there is no motivation or suggestion in the EP Application to provide the arrangement as recited in amended claims 1, 23, and 54. Specifically, due to the nature of the ornament arrangements shown in Figures 11 and 12 of the EP Application, inserting wires 14 into the apertures of ornament 6 cannot be practiced without modifying the wire 14 and its mounting to wires 4 and 5 by means of some undisclosed and unsuggested fashion. Thus, the Applicant submits that the invention recited in claim 1, 23, and 54 are also not obvious in view of the teachings of the EP Application.

With respect to the rejections of dependent claims 3, 4, 9, 10, 12-14, 24, 25, 50, 55-58, 63, and 64, the Applicant submits that these claims are not anticipated by the EP Application for the same reasons that claims 1, 23, and 54, from which they depend, are not anticipated. The Applicant requests that these rejections be reconsidered and withdrawn.

Application No.: 10/774,264
Amendment dated July 6, 2006
Reply to Office Action of March 7, 2006

4. Response to Anticipation Rejection based upon the EP Application

In paragraph 7 on pages 6-8 of the Office Action, the Patent Office also rejected claims 1, 3, 4, 10, 12-14, 23-25, 50, 54-58, 63, and 64 under 35 USC §102(b) as anticipated by Figure 23 of the EP Application. However, Applicants respectfully submit that the EP Application does not include “each and every element” of the invention recited in these claims, nor does the EP Application show the invention “in as complete detail” as in these claims.

With respect to the rejection of claims 1, 23, and 54, the Applicant submits that, in an argument similar to the argument presented above with respect to Figures 11 and 12 of the EP Application, the wires shown in Figure 23 are not “inserted into and bent to engage” the ornament apertures as recited in these claims. Though the wires 5 shown in Figure 23 extend from an upper ring 1 to a lower ring 2 and pass through a plurality of ornaments 6, wire 5 does not engage each aperture in ornament 6 as claimed, that is, by bending the wire to engage the aperture in the ornaments. The wires 5 in Figure 23 clearly require the “spacing beads” to position ornaments 6. The Applicant submits that amended claims 1, 23, and 54 are not anticipated by the EP Application.

With respect to the rejections of dependent claims 3, 4, 9, 10, 12-14, 24, 25, 50, 55-58, 63, and 64, the Applicant submits that these claims are not anticipated by Figure 23 of the EP Application for the same reasons that claims 1, 23, and 54, from which they depend, are not anticipated. The Applicant requests that these rejections be reconsidered and withdrawn.

5. Response to Anticipation Rejection based upon Schonbek

In paragraph 8 on pages 10-12 of the Office Action, the Patent Office rejected claims 29-38 and 60-62 under 35 USC §102(b) as anticipated by U.S. Patent 5,144,541 of Schonbek [herein “Schonbek”]. However, the Applicant respectfully submits that Schonbek does not include “each and every element” of the invention recited in these claims, nor does Schonbek show the invention “in as complete detail” as these claims.

Application No.: 10/774,264
Amendment dated July 6, 2006
Reply to Office Action of March 7, 2006

The Patent Office is again advised that the assignee of Schonbek is the same as the assignee of the present application. In fact one of the co-inventors of the present application, Andrew J. Schonbek, is the son of the sole inventor that appears on Schonbek, Arnold Schonbek. Clearly, the Applicant is familiar with the art of Schonbek and its distinctions from the present invention recited in claims 29 and 37 and their dependents.

With respect to claim 29 and 37, as discussed during the above referenced phone conversation, the Applicant submits that ring 70 shown in Figure 5 of Schonbek is not a vertically-oriented plate, as now recited in these claims. The view of ring 70 shown in Figure 5 is a plan view of the ring 70 shown in Figure 6 of Schonbek. As shown in Figure 6, ring 70 is a horizontally mounted ring having perforations from which ornaments 78, 90 are vertically suspended. This horizontal ring 70 of Schonbek contrasts with the vertical plate orientation of the aspect of the inventions illustrated in, for example, Figures 43-47 of the instant application. This distinction of Schonbek from the present invention was recognized and acknowledged by Examiner Reese in the above referenced phone conversation. In a bona fide attempt to comply with Examiner Reese's request to clarify the vertical orientation of the claimed plate, in the above Amendment, the Applicant amended claims 29 and 37 to clearly recite that the plate of the present invention is substantially vertically oriented. The Applicant requests that this rejection be reconsidered and withdrawn.

With respect to the rejections of dependent claims 30-38, and 60-62, the Applicant submits that these claims are not anticipated by Schonbek for the same reasons that claims 29 and 37, from which they depend, are not anticipated. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

6. Allowable Subject Matter

In paragraph 9 on page 13 of the Office Action, the Patent Office identified the subject matter recited in claim 39 as allowable if rewritten in independent form. The

Application No.: 10/774,264
Amendment dated July 6, 2006
Reply to Office Action of March 7, 2006

Applicant recognizes with appreciation the acknowledgment of the allowability of this subject matter. However, as discussed above, Applicants believe that the Applicant is entitled to further protection in view of the prior art cited in the Office Action.

7. Conclusion

The Applicant believes that this Amendment and Remarks overcome the rejections of the subject Office Action and place the application in condition for allowance. An early and favorable action on the merits of the application is requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned Agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



John Pietrangeli
Agent for Applicants
Registration No. 39,331

Dated: July 6, 2006.

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579